

Application No. 10/518,886  
Docket No. 2002B096/2  
Amdt. dated April 3, 2006  
Reply to Office Action of December 1, 2005

### REMARKS

This reply is in response to the Office Action dated December 1, 2005. Claims 1-50 are pending in the application and stand rejected. Applicant has amended the claims to correct matters of form and/or to correct deficiencies under 35 U.S.C. § 112, second paragraph, as discussed below. Applicant has also canceled claim 8 without prejudice and presented the subject matter of claim 8 in independent form by amending base claim 1. Entry of the foregoing amendment and reconsideration of the claims is respectfully requested.

Claims 1-23, 35 and 36 stand rejected under 35 U.S.C. § 112, second paragraph. Applicant has amended claims 1 and 34 to obviate the rejection with respect to those claims and those that depend therefrom. In particular, Applicant has amended claims 1 and 34 to remove the term "substantially absent," although the term "substantially absent" is defined in the specification at page 23, lines 6-8, as "not... deliberately added to the composition." Such amendment does not narrow the amended claims and therefore, those amended claims are entitled to a full range of equivalents. Withdrawal of the rejection is respectfully requested.

Furthermore, Applicant has amended claims 12, 13, 35 and 36 for reasons noted by the Examiner, obviating the rejection with respect to those claims. Such amendments are not presented to distinguish a reference; therefore, these amended claims are entitled to a full range of equivalents. Withdrawal of the rejection is respectfully requested.

Claims 1-50 stand rejected under 35 U.S.C. § 102(a or e), as being anticipated by Tsou et al. (either US 6,875,813 or WO 200157340) hereafter "Tsou."

Applicant respectfully traverses the rejection. Tsou discloses an isobutylene based elastomer blend having a semi-crystalline copolymer of ethylene and an alpha-olefin having from 4 to 16 carbon atoms. See, Tsou at Abstract and at col. 3, line 64 through col. 5, line 54. Tsou does not teach, show, or suggest a composition suitable for an air barrier comprising an elastomer, processing oil and plastomer, wherein the plastomer is a copolymer of ethylene derived units and C<sub>3</sub> to C<sub>10</sub> α-olefin derived units and has a density of less than 0.915 g/cm<sup>3</sup>, as recited in the base claims and those dependent therefrom. Accordingly, withdrawal of the rejection and allowance of the claims is respectfully requested.

Claims 1-50 stand rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-24 of Tsou. For reasons discussed above, Tsou does not teach, show or suggest the claimed invention and therefore, claims 1-50 are not anticipated by or obvious over the

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claims of Tsou. Accordingly, a rejection on the grounds of nonstatutory obviousness-type double patenting should be withdrawn. Withdrawal of the rejection and allowance of the claims is respectfully requested.

Claims 1-7 and 11-23 stand rejected under 35 U.S.C. § 102(b), as being anticipated by Simonutti et al. (US 6,030,304) hereafter "Simonutti."

Applicant has amended claim 1 to include the subject matter of claim 8, obviating this rejection. Therefore, withdrawal of the rejection and allowance of the claims is respectfully requested.

Claims 8-10 and 24-50 stand rejected under 35 U.S.C. § 103(a), as being unpatentable over Simonutti, in view of Coran (US 4,130,534) hereafter "Coran." The Examiner admits Simonutti does not disclose or suggest a processing oil. Yet, the Examiner asserts that because Coran "discloses an elastomeric composition and that extender oil is 'desireable' to improve processability and other properties," it would have been obvious to use extender oil in the composition of Simonutti as taught by Coran "to improve properties, absent any showing of surprising or unexpected results."

Applicants respectfully traverse the rejection on grounds that a combination of the references does not teach, show, or suggest the claimed invention. Simonutti discloses a composition having a rubber component and a plastomer for a pressureless tennis ball. Simonutti does not disclose or suggest a processing oil. Based on the disclosure of Simonutti and the problem to be solved in Simonutti, the composition is designed to replace compositions used for pressurized tennis balls. Therefore, one of ordinary skill in the art would conclude that a processing oil would be unsuitable for those balls, and that the Simonutti composition is not suitable for an air barrier. Coran does not cure the deficiencies of Simonutti. Therefore, a combination of the references does not teach, show or suggest a composition suitable for an air barrier comprising an elastomer comprising C<sub>4</sub> to C<sub>7</sub> isoolefin derived units, a processing oil, and a plastomer, wherein the plastomer is a copolymer of ethylene derived units and C<sub>3</sub> to C<sub>10</sub> α-olefin derived units and has a density of less than 0.915 g/cm<sup>3</sup>, as recited in the base claims and those dependent therefrom.

Applicants also respectfully traverse the rejection on grounds that the Examiner has not established a *prima facie* case of obviousness. To establish *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. See In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Further, the teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, not in the applicants' disclosure. See M.P.E.P. § 2143, citing In re Vaack, 947 F.2d 488 (Fed. Cir. 1991). Still further, the

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examiner must *particularly* identify any suggestion, teaching or motivation from *within* the references to combine the references (emphasis added). See In Re Dembiczak, 50 USPQ2d 1614 (Fed. Cir. 1999). Here, the Examiner has provided no suggestion, teaching or motivation from *within* the references to combine their teachings. For at least this reason, withdrawal of the rejection and allowance of the claims is respectfully requested.

Instead, the Examiner has merely stated that the motivation to combine the references is to "improve properties." The Examiner is kindly reminded that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). No such desirability of the combination can be deduced from these references. Simonutti is focused on pressureless tennis balls. Extendability is not a concern of Simonutti since greater stiffness is highly desired for the balls. In fact, such proposed modification would render the balls of Simonutti unsatisfactory for its intended purpose. Therefore, such proposed modification asserted by the Examiner is improper because a modification cannot render the prior art unsatisfactory for its intended purpose. In re Gordon, 221 USPQ 1125 (Fed. Cir. 1984). For at least this reason, withdrawal of the rejection and allowance of the claims is respectfully requested.

Insofar as the record shows, if it is true that processing oils provide "improved properties" it has been gleaned from the Applicant's own specification. That is nothing more than impermissible hindsight reasoning. Nowhere has the Examiner identified a teaching or suggestion, whether expressed or implied, from within the references themselves to arrive at the desirability of the combination alleged by the Examiner, i.e. the claimed invention. Therefore, the Examiner has not established a *prima facie* case of obviousness, and withdrawal of the rejection and allowance of the claims is respectfully requested.

Moreover, neither Simonutti nor Coran teach, show or suggest polybutene processing oil in combination with an elastomer and plastomer as recited in claim 24 and those dependent therefrom. Further, neither Simonutti nor Coran teach, show or suggest the amounts of processing oil relative to the rubber content as recited in claims 10 and 32. Allowance of at least those claims is respectfully requested.

Having addressed all issues set out in the office action, Applicant respectfully submits that the pending claims are now in condition for allowance. Applicant invites the Examiner to telephone the undersigned attorney if there are any issues outstanding which have not been addressed to the Examiner's satisfaction. A petition for extension of time for filing this response is attached; however, in the event

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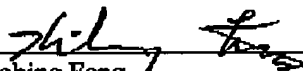
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that petition becomes separated from this Response, the Commissioner is hereby authorized to charge counsel's Deposit Account No. 05-1712, for any fees, including extension of time fees or excess claim fees, required to make this response timely and acceptable to the Office.

Respectfully submitted,

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Date

  
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